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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/683,715   | 10/10/2003  | David S. Benco       | LUC-429/Benco<br>42-31-31-36 | 2046             |
| 32205  | 7590        | 07/21/2005           | EXAMINER                     |                  |
| PATTI & BRILL<br>ONE NORTH LASALLE STREET<br>44TH FLOOR<br>CHICAGO, IL 60602 |             |                      | D AGOSTA, STEPHEN M          |                  |
|  |             |                      | ART UNIT                     | PAPER NUMBER     |
|  |             |                      | 2683                         |                  |

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/683,715

Applicant(s)

BENCO ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The abstract of the disclosure is objected to because there should be no title on the page. Correction is required. See MPEP § 608.01(b).

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims **so they are no longer coextensive in scope**. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-5 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 09-815854. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-5** rejected under 35 U.S.C. 102(b) as being anticipated by Snellman WO98/23108.

As per **claims 1 and 3**, Snellman teaches a method for automatically updating a non-emergency telephone number stored in a wireless handset (abstract teaches stored phone numbers in a mobile device and page 2, 2<sup>nd</sup> paragraph teaches supporting both emergency and non-emergency numbers, eg. “help, guidance and so on”. Page 10, last paragraph to page 11 discusses guidance as a person needing directions to a certain address which is a non-emergency situation) comprising the steps of:

determining a previous non-emergency telephone number corresponding with a prior location of the wireless handset AND storing the previous non-emergency telephone number in a record associated with the wireless handset in a network database (page 3, bottom paragraph, lines 3-4 state “predetermined telephone numbers of various local operators and/or local services are stored into memory of the mobile phone”);

determining a current location of the wireless handset (page 7, bottom paragraph teaches the mobile networks keeping track of the mobiles location via HLR/VLR systems);

determining a first non-emergency telephone number corresponding to the current location where the first non-emergency telephone number is to be used by wireless handsets at the current location to seek non-emergency assistance AND comparing the first non-emergency telephone number and the previous non-emergency telephone number AND if the first non-emergency telephone number is different than the previous non-emergency telephone number, transmitting a message

containing the first non-emergency telephone number to the wireless handset where the message is a command for the wireless handset to store in its memory the first non-emergency instead of the previous non-emergency telephone number for access by a user of the wireless handset (page 7, 1<sup>st</sup> four paragraphs discuss a user dialing a phone number and it being changed to a different phone number depending upon the user's location, eg. if in Finland, a "911" call will be changed to a "112" call, and vice versa. **Note** that page 7, 4<sup>th</sup> paragraph states that the phone number can be changed/updated in memory as well, which reads on the claim – also see page 8, 2<sup>nd</sup> and 4<sup>th</sup> paragraphs as well as page 10, 2<sup>nd</sup> paragraph and claim 9, page 13).

As per **claim 2**, Snellman teaches claim 1 wherein the step of determining the corresponding first non-emergency telephone number comprises accessing a database based on the current location of the wireless handset where the database stores non-emergency telephone numbers for different locations (page 10, claim 9 teaches updating the mobile device memory with telephone number information based on the user's new location whereby the update signal/data is transmitted from the network, eg. a database).

As per **claim 4**, Snellman teaches claim 3 further comprising the steps of storing in a network database the prior location in a record associated with the wireless handset, and comparing the prior location with the current location (page 7, bottom paragraph teaches keeping track of prior/current location of a mobile via HLR and VLR, as is well known in the art).

As per **claim 5**, Snellman teaches claim 3 further comprising the steps of determining whether the current non-emergency telephone number corresponding to the current location is different from the prior non-emergency telephone number corresponding to the prior location, and transmitting said message only if the current non-emergency telephone number differs from the prior non-emergency telephone number handset (page 7, 1<sup>st</sup> four paragraphs discuss a user dialing a phone number

and it being changed to a different phone number depending upon the user's location, eg. if in Finland, a "911" call will be changed to a "112" call, and vice versa. **Note** that page 7, 4<sup>th</sup> paragraph states that the phone number can be changed/updated in memory as well, which reads on the claim – also see page 8, 2<sup>nd</sup> and 4<sup>th</sup> paragraphs as well as page 10, 2<sup>nd</sup> paragraph and claim 9, page 13).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Armbruster et al. US 6,070,065
2. Chang et al. US 6,463,270
3. Arami et al. US 5,920,610
4. Griffith et al. US 6,195,558
5. Sommerer US 6,701,348
6. Miura US 6,643,363
7. Weiner US 2004.0204117
8. Rodriguez et al. US 2002/0068599
9. Shaffer US 6,351,636

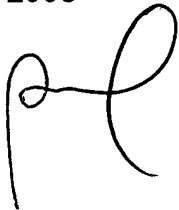
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta  
Primary Examiner  
6-20-2005

A handwritten signature in black ink, appearing to be 'SD' or 'S.D.', with a large loop at the end.